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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,915	08/28/2006	Kari Raisanen	METSO-64	7851
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EXAMINER				
FORTUNA, JOSE A				
ART UNIT		PAPER NUMBER		
1791				
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01/23/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/597,915

Applicant(s)

RAISANEN ET AL.

Examiner

José A. Fortuna

Art Unit

1791

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 8/11/06
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 33-65 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 31-62 of copending Application No. 10/597,940 in view of US Patent No. 6,342,125. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference in the claims is the manner in which the different layers or plies are joined, i.e., the second layer is formed on top of the first layer in the current application, while in the co-pending application the second layer is formed and joined to the first layer while is still wet. However, the different ways in which the webs are joined are very well known in the art and within the pervious of one of ordinary skill in the art, see for example column 1, lines 34-44 of US Patent No. 6,342,125.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 33-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nordström, US Patent No. 6,342,125 or Mansson et al., US Patent Application Publication No.

2003/000666 or Oka et al., US Patent No. 3,891,501 or Roell, US Patent No. 3,856,618 in view of Egelhof et al., US Patent No. 5,972,168 or Turner et al., US Patent No. 4,830,709 or Kotitschke, US Patent No. 5,914,009 or Bubik et al., US Patent No. 5,259,929.

All of the primary references, Nordström, Mansson et al., Oka et al, and Roell, teach a process and apparatus of making a multi-layer/multi-ply web, in which a first web is formed and while still wet a second is formed on top of it, i.e., a papermaking slurry is deposited on top of the first one, see figures. The primary references fail to teach the use of a non-pulsating dewatering zone, formed by a curved shoe, followed by a pulsating dewatering zone as claimed. However, all of the secondary references teach dewatering mechanisms in which a web is formed/dewatered by passing it through a curved shoe, which could include a suction member, i.e., vacuum, and then passed through a second dewatering zone comprising pulsating mechanisms, i.e., dewatering foils or lists, see: Egelhof et al., figures and column 3, lines 6-57; Turner et al., figures and column 3, line 9, through column 4, line 51; Kotitschke, figures and column 1, line 54 through 4, line 9; Bubik et al., figures and column 3, line 33 through column 5, line 40. All of the secondary references teach that such configuration improves the dewatering, retention of the web and improves the formation of the web, i.e., achieve a uniform formation of the paper web. Bubik et al., in the abstract, teach that “[D]ue to this arrangement there is possible to optimum formation of the paper web or sheet with the use of very little dilution water for the fiber stock suspension...”; Kotitschke teaches that the particular arrangement creates a two uniformly formed external layers, column 1, lines 19-31; Turner et al., the arrangement produces a composite multi-ply web which has superior

overall ply bond, retention and dryness before leaving the web forming section of a papermaking machine, see abstract; Egelhof et al., better paper formation and can be easily adapted to different operation conditions, (with regard to quantity and drainage behavior of the fiber suspension), column 2, lines 51-57. Therefore, using the dewatering systems/methods of the secondary references in the multiply process and devices of the primary references would have been obvious to one of ordinary skill in the art in order to improve formation, retention and drainage of the fibrous pulp and better ply bonding of the webs. Note that the different claimed configurations of a Fourdrinier and a twin wire is disclosed by the primary references and the secondary references teach the movable and/or stationary lists or slats. With regard to the angle and radius of curvature of the caps, i.e., the curvature of the surface of the shoe, this is considered to be an optimization of the surface and position of the shoe in order to obtain the optimal dewatering/retention and better formation of the paper web. It has been held that “[T]he discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art. *In re Antoine*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); *In re Aller*, 42 CCPA 824, 220 F.2d 454, 105 USPQ 233 (1995).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art of “Multi-layer web formation section.”

Any inquiry concerning this communication or earlier communications from the examiner should be directed to José A. Fortuna whose telephone number is 571-272-1188. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/José A Fortuna/
Primary Examiner
Art Unit 1791

JAF